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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,029	11/13/2000	Dae-Woo Lee	4234-9	9120

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EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,029

Applicant(s)

LEE, DAE-WOO

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-3 and 9, in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there are no claims directed to the product. It is noted that presently there are no claims directed to the product. However, the restriction is between the method of manufacturing and the method of use, and the two methods are directed to patentably distinct inventions. For example, the product made by the process of Group I can be used in other processes than that of Group II such as one where the sheet attaches between two structure surfaces (e.g. double sided adhesive tape). Therefore, applicant's arguments are not found persuasive.
2. The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

4. Claims 1-3 and 9 are objected to because of the following informalities: In claim 1, line 1 after "composed of at" insert - - least - -. In claim 2, line 2 delete "phenyllenediamin" and insert therein - - phenylenediamine - -. In claim 2, line 3 delete "styremeated" and insert therein - - styrenated - -. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draexler (U.S. Patent 4,551,392) in view of Hoover (U.S. Patent 2,656,292).

Draexler is directed to a composite material for use in a building element wherein the material comprises multiple sheets (layers) including a distinct sheet of EPDM (synthetic rubber), vulcanizing agent, and additives (Column 1, lines 6-7 and 46-49 and Column 2, lines 12-16). Draexler teaches that the sheet is resistant to heat and ozone and exhibits swelling resistance against polar, organic media (water) (Column 1, lines 9-11). Draexler teaches that the additives in the sheet include age resistor (age retarders including polymerized trimethyl dihydroquinoline), an adhesion-providing agent (tackifying resin), a softener (plasticizer oils), and filler material (Column 2, lines 55-63 and Column 4, line 55). Draexler teaches using conventional techniques such as mixers, rollers, and calenders to form the EPDM, vulcanizing

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agent, and additives into a vulcanizable composition sheet (layer) of a desired width and thickness (Column 3, lines 5-15 and 49-51 and Column 4, lines 14-17). The vulcanizable composition sheet can then be welded to other material sheets to form a building element (Column 4, lines 14-15). Draexler is silent as to attaching a release paper to upper and lower surfaces of the sheet. However, it is well known in the art when forming a rubber sheet with a tacky surface to attach a release sheet to its upper and lower surfaces to prevent tearing or damaging the sheet during handling, storage, or transportation as shown by Hoover. One of ordinary skill in the art at the time the invention was made reading Draexler in view of Hoover would have readily appreciated modifying Draexler to include providing a release paper on the upper and lower surfaces of the vulcanizable composition sheet as suggested by Hoover to prevent tearing or damaging the sheet during handling, storage, or transportation of the sheet prior to welding the sheet with other materials to form a building element.

Hoover is directed to a tacky rubber sheet having a non-stick liner applied to both sides of the sheet (Figures 1-3 and Column 1, lines 1-12 and Column 3, lines 13-16 and 24-29). Hoover teaches that the liner prevents tearing or damaging the sheet during handling, storage, or transportation (Column 2, lines 24-30).

7. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draexler and Hoover as applied above in paragraph 6, and further in view of Nottebohm (U.S. Patent 2,338,960) and McCortney (U.S. Patent 2,080,730).

Draexler and Hoover as applied above teach all of the limitations in claims 3 and 9 except for a teaching on using tragacanth rubber or polyvinyl poval as the adhesion-providing agent (tackifying resin). However, it is well known and conventional in the art to use tragacanth

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rubber as an adhesion-providing agent in rubber compositions as shown for example by Nottebohm and McCortney. One of ordinary skill in the art at the time the invention was made would have readily appreciated incorporating as the adhesion-providing agent in the method taught by Draexler as modified by Hoover tragacanth rubber as was conventional in the art and shown for example by Nottebohm and McCortney as only the expected results would be achieved.

Nottebohm is directed to a rubber binder that includes tragacanth as the binding agent (Column 1, lines 44-55 and Column 2, lines 1-2). McCortney is directed to a rubber cement composition that includes tragacanth as the resin (Page 1, lines 7-12 and Page 2, lines 25-30).


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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


John L. Goff
September 18, 2002


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700